

Response Under 37 C.F.R. § 1.111  
Appln. No.: 09/541,597

REMARKS

Claims 1-13 are all the claims pending in the application. Claims 1-3 and 9-13 are allowed. Claims 4-8 are rejected.

As indicated in the Advisory Action dated April 8, 2003, the Examiner maintains the rejection of claims 4-8 based on Goodall et al in view of Allen et al and Aoai et al. In particular, the Examiner states that the "Declaration does not provide evidence of unexpected results when using a surfactant" and that "[a] comparison of the compositions with and without surfactant show the same levels of defects in that no surfactant gives a higher level of defects and with the surfactant the defects are substantially less."

In addition to the remarks submitted with the RCE filed April 18, 2003, and the evidence already of record, Applicants submit herewith an executed Declaration Under 37 C.F.R. §1.132 by Mr. Kenichiro Sato. In the Declaration, the resins used were those set forth in Examples 56 and 58 in Goodall et al (within the scope of the present invention) and the resin set forth in Example 60 in Goodall et al (a comparative resin, outside the scope of the present invention). Examples b and g shown in Table 1 of the Declaration are the same as Examples b and g, included in the executed Declaration Under 37 C.F.R. §1.132 by Mr. Sato filed November 22, 2002.

Comparative Example 1 uses a resin which is outside the scope of the present invention and uses the specified surfactant which is within the scope of the present invention. As is apparent from the comparison of Examples b and g with Comparative Example 1, Comparative Example 1 fails in forming satisfactory images, and cannot achieve an unexpected and excellent effect similar to that of the present invention, as for the number of development defects as well as the defocus latitude depended on line pitch.

Additionally, in Comparative Example 2, wherein no surfactant is included, the number of development defects and the particle (initial value) further deteriorate compared to those of Comparative Example 1 and the inventive samples.

Therefore, the present invention achieves particularly preferable and unexpected effects on the number of development defects and DOF pitch dependency by the combination of a specified resin with a specified surfactant, not by the effect of the specified surfactant alone. See also Comparative Examples b' and g', wherein no surfactant is incorporated, included in the data of the executed Declaration Under 37 C.F.R. §1.132 by Mr. Sato filed November 22, 2002.

Another unexpected advantage is seen in the order of the particle (initial value), where the compositions of the present application unexpectedly show small particle numbers immediately after preparation.

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It is noted that the Declarant, Mr. Sato, concludes that the results seen with the present invention are excellent and can not be expected from the cited reference. When an Applicant demonstrates substantially improved results and states that the results were unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary. In re Soni, 34 USPQ2d 1684, 1688 (CA FC 1995).

Further, as is apparent from the data already submitted, the effect of the present invention is not due to the surfactant alone. By comparing Example b with Comparative Example b' in the data already submitted, the present invention is clearly shown to exhibit excellent effects on number of development defects and DOF pitch dependency by using a specified resin together with a specified surfactant both characterizing the present invention. Moreover, as is seen from the particle (initial value), the number of particles is small in the composition of the present invention from immediately after preparation. Again, this is another unexpected feature obtained by the present invention.

Still further, as is seen by comparing Example b with Comparative Example b'', it is impossible to achieve an effect similar to that of the present invention by combining a surfactant (W-4) outside the scope of the present invention with a resin within the scope of the present invention. Therefore, the present invention achieved excellent and unexpected effects by the combination of the claimed resin with the

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claimed surfactant, and the results are not achieved by the effect of the surfactant alone.

Thus, the present invention shows unexpected superiority over the combination of Goodall, which does not disclose the surfactant of the present invention, and Aoai and Allen, which do not disclose the resin of the present invention.

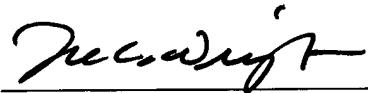
For the above reasons, it is respectfully submitted that the subject matter of claims 4-8 is not made obvious by the disclosures of Goodall in view of Allen and Aoai and it is requested that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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